

Application No.: 09/890482

Case No.: 53852US013

### REMARKS

The Office Action dated January 25, 2005 has been received and reviewed. Claims 6-27 and 29-30 have been cancelled, and claims 31-34 have been added. The pending claims are claims 28 and 31-34. Reconsideration and withdrawal of the rejections are respectfully requested.

#### Claim Amendments

New claims 31-34 substantially include the elements of previously presented claims 7-10 and were written to depend from independent claim 28. No new matter was added.

#### 35 U.S.C. § 103(a) Rejections

Claims 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arends (U.S. Patent No. 5,360,659) in view of Oi (U.S. Patent No. 5,804,102) and Isoda (U.S. Patent No. 3,928,760) and either Van der Voort (U.S. Patent No. 4,937,661) or Vriens (U.S. Patent No. 4,804,884).

Applicants traverse this rejection. However, to further move this case towards issuance, Applicants have cancelled claims 6-10, thereby rendering this rejection moot. Applicants reserve the right to present the subject matter of cancelled claims 6-10 in subsequently filed continuation applications.

Claims 11-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arends in view of Ouderkirk et al. (WO 97/01778) and further in view of Lechter (U.S. Patent No. 5,101,139).

Applicants traverse this rejection. However, to further move this case towards issuance, Applicants have cancelled claims 11-19, thereby rendering this rejection moot. Applicants reserve the right to present the subject matter of cancelled claims 11-19 in subsequently filed continuation applications.

Claims 20-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arends in view of Ouderkirk et al., Lechter, and further in view of Oi.

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Applicants traverse this rejection. However, to further move this case towards issuance, Applicants have cancelled claims 20-27, thereby rendering this rejection moot. Applicants reserve the right to present the subject matter of cancelled claims 20-27 in subsequently filed continuation applications.

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ouderkirk et al. in view of Oi and Isoda, and further in view of either Van der Voort or Vriens. The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the multilayer IR filter of Ouderkirk et al., a filter which substantially reflects incident IR radiation, in conjunction with an IR remote control detector in order to prevent the incidence of unwanted IR radiation upon the detector and therefore cause deleterious effects, as taught by Oi, by simply placing the filter in front of the detector, as taught by Isoda. The Office Action further alleges that such "simple arrangement" would substantially prevent most of the IR radiation from being incident onto the remote control detector, thus preventing possible malfunction of the device.

Applicants traverse this rejection and submit that claim 28 is not *prima facie* obvious in view of the cited references because there is no suggestion or motivation to combine the cited references as suggested by the Office Action. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Applicants respectfully submit that combining the teachings of the cited references in the manner suggested by the Office Action would render the inventions described in such references unsatisfactory for their intended purposes. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). For example, the Office Action states that Ouderkirk et al. teaches a filter that "substantially

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reflects incident IR radiation.” See Office Action, page 9. The Office Action further alleges that Isoda teaches a remote control device that includes an optical filter 14 in front of an optical detector 15. See Office Action, page 3. The Office Action states that “[t]he role of the optical filter 14 of Isoda is to prevent passage of light of unwanted wavelengths (in this case visible light, i.e., the filter only allows passage of IR light).” The Office Action suggests placing the IR reflecting filter of Ouderkirk et al. in front of the detector 15 taught by Isoda. However, placing an IR reflecting filter in front of the detector 15 of Isoda would prevent the signal from the diode 3 (as illustrated in FIG. 4A) from reaching the detector 15. This would prevent the television receiver 2 of Isoda from being remotely controlled by the transmitter 1. Therefore, the Office Action’s suggested modification of Isoda would render the invention taught by Isoda unsatisfactory for its intended purpose. The addition of either Van der Voort or Vriens does nothing to cure the deficiencies already present in the combination of Ouderkirk et al., Oi, and Isoda. As a result, there is no suggestion or motivation to combine the teachings of Ouderkirk et al. with those of Oi, Isoda, and either Van der Voort or Vriens.

Claims 31-34, which depend from claim 28, are patentable for the same reasons as those provided above for claim 28. In addition, claims 31-34 each recite additional elements that further support patentability when combined with claim 28.

For at least the above reasons, Applicants submit that claims 28 and 31-34 are patentable over the cited references. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ouderkirk et al. in view of Lechter.

Applicants traverse this rejection. However, to further move this case towards issuance, Applicants have cancelled claim 29, thereby rendering this rejection moot. Applicants reserve the right to present the subject matter of cancelled claim 29 in subsequently filed continuation applications.

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ouderkirk et al. in view of Lechter and Oi.

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Applicants traverse this rejection. However, to further move this case towards issuance, Applicants have cancelled claim 30, thereby rendering this rejection moot. Applicants reserve the right to present the subject matter of cancelled claim 30 in subsequently filed continuation applications.

Summary

It is respectfully submitted that the pending claims are in condition for allowance. Reconsideration and withdrawal of all rejections are respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

June 27, 2005  
Date

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